

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Shigeura et al.

Serial No.: 09/908,994

Filed: July 17, 2001

For: **APPARATUS AND METHOD FOR SPECIFIC  
RELEASE OF CAPTURED EXTENSION  
PRODUCTS**

Group Art Unit: 1634

Examiner: B. Sisson

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Date of Deposit: April 4, 2003Signature: Mila T. KasanType Name of Depositing Party: Mila T. Kasan**RESPONSE**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

With reference to the Office action mailed December 4, 2002, reconsideration of the application is respectfully requested. A Petition for 1-Month Extension of Time is enclosed herewith, extending the deadline for response to April 4, 2003.

**REMARKS**

Claims 10-14 and 16-20 were rejected as allegedly being obvious over O'Neil et al. (US 6,124,092). Claim 15 was rejected as allegedly being obvious over O'Neil et al. in view of Hellyer et al. (US 6,207,818). The rejections are respectfully traversed.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the cited art. Further, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious (MPEP 2143.03).

In the present case, O'Neil et al. fails to teach at least the following element of independent claim 10 of the instant application:

"after said specific binding, releasing bound polynucleotides from a selected support by altering a physical property of that support while leaving unaltered the same physical property of at least one other of the supports."

Further, O'Neil et al. *teaches away* from the present invention. In particular, O'Neil et al. states at column 3 lines 54-61 that

Regarding claim 15, the Examiner characterized Hellyer as disclosing "a method of effecting stringency of hybridization conditions whereby one or more nucleic acids are immobilized to a solid support such as an array through manipulation of the voltage at specific sites on the support (see columns 3-4). Accordingly, one of skill in the art can manipulate hybridization conditions through voltage on parallel with that of temperature manipulation" (Office action at paragraph 16).

However, Hellyer et al. fails to teach at least the following element of parent claim 10:

"after said specific binding, releasing bound polynucleotides from a selected support by altering a physical property of that support while leaving unaltered the same physical property of at least one other of the supports."

Accordingly, claim 15, which depends from independent claim 10, cannot be considered obvious.

**FEE AUTHORIZATION AND REQUEST FOR TIME EXTENSION**

If an extension of time is required for timely filing of this response, such time extension is hereby requested. If any additional fees not submitted with this response are required, please take such fees from Applied Biosystems Deposit Account No. **01-2213 (Order No. 4470US)**.

Respectfully submitted,

Date: April 4, 2003

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